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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/463,096	04/12/2000	HANS TANDLER	GK-ZEI-3078	5855

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REED SMITH, LLP

ATTN: PATENT RECORDS DEPARTMENT  
599 LEXINGTON AVENUE, 29TH FLOOR  
NEW YORK, NY 10022-7650

EXAMINER

FINEMAN, LEE A

ART UNIT PAPER NUMBER

2872

DATE MAILED: 01/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/463,096	Applicant(s) TANDLER ET AL.	
	Examiner Lee Fineman	Art Unit 2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10/31/05.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 13, 15, 17-23, 25-28, 30 and 31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13, 15, 17-23, 25-28, 30 and 31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 4/1/00 & 9/11/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This Office Action is in response to an amendment filed 31 October 2005 in which claims 13, 25, 27 and 31 were amended and claim 29 was cancelled. Claims 13, 15, 17-23, 25-28 and 30-31 are pending.

#### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 13, 15, 17-23, 25-28 and 30-31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification fails to specifically identify the newly added limitation of the control unit controlling the motors according to the mathematical controlling curve "without regard to the position of a specimen to be observed". In fact, as detailed on page 4, lines 3-7, the zoom system motors are specifically moved with regard to a specimen (i.e., a test object) at least to provide calibration and further claim 23 calls for the control unit to be used for motorized focusing which must take the position of a specimen into consideration. The applicant is now relying on this limitation as criticalness to the patentability. As such, the examiner contends, absent specific support in the specification, that this subject

matter was not considered within the metes and bounds of the invention as originally filed. The dependent claims inherit the deficiencies of the claim from which they depend.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 13, 15, 17-21, 23, 25-26, 28 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Figure 1 of the instant application which is admitted prior art (Admission) in view of Nagashima et al., US. 5,742,735 and Kaneda, US 5,973,857.

Regarding claims 13, 15, 17 and 23, Admission discloses a stereomicroscope with a zoom system (fig. 1) comprising a drive motor (M) driving at least one moving lens system (L1 or L2) having first and second moving lenses (unnumbered pair of lenses in L1 or L2) that are provided as lens pairs in a Greenough type stereomicroscope or telescope type stereomicroscope (Admission, fig 1) wherein the motor is controlled without regard to the position of a specimen to be observed (only the mechanical curve is followed). Admission lacks first and second linear direct driving motors having a step-wise resolution being controlled by a control unit which reads from a memory calculated pre-stored values of reference points from a mathematical controlling curve for simultaneously directing the movement of the first and second moving lenses by controlling the driving motors in a corresponding manner to cover a different number of discrete individual steps per unit according to the mathematical curve without necessitating

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use of mechanical generation of the mathematical controlling curve; and the control unit being used for motorized zoom adjustments and motorized focusing of the microscope. Nagashima et al. teaches a zoom system with first and second driving means (9 and 10) being controlled by a control unit (6) which reads from a memory (column 2, lines 55-56) calculated pre-stored values of reference points from a mathematical controlling curve for directing the movement of first and second moving lenses (2 and 3) by controlling the driving means in a corresponding manner without necessitating use of mechanical generation of the mathematical controlling curve (column 3, lines 13-24) and the control unit being used for motorized zoom adjustment and for motorized focusing (column 3, lines 13-18). It would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the drive unit of Admission with a drive unit of Nagashima et al. to provide a more simple system with less moving parts. Nagashima et al. discloses driving means to linearly move the lens groups. This arrangement appears to be direct linear drive motors having a step-wise resolution. However in as much as direct linear drive motors are not explicitly disclosed, use of such motors are well know in the art for zoom systems. For example, Kaneda teaches zooming wherein direct linear driving motors having a step-wise resolution are used (stepper motors, column 4, lines 48-51). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to use well known direct linear drive motors to provide precise linear movement of the lens groups. Further, although Nagashima demonstrates different tracking curves for each lens movement, Nagashima does not explicitly state that the driving motors are controlled in a corresponding manner to the lenses to cover a different number of discrete individual steps per unit according to the mathematical curve. Kaneda further teaches variable speed stepper motors for ease of positioning

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different lens groups (column 14, lines 9-16). It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the motors variable speed (i.e., cover a different number of discrete individual steps per unit) as suggested by Kaneda provide faster zooming (Kaneda, column 14, line 27-33).

Regarding claim 20, Admission in view of Nagashima et al. and Kaneda further disclose wherein the at least one moving lens system (L1 or L2) are a plurality of moving lens members and are controlled jointly (Admission, fig. 1).

Regarding claims 18 and 19, Admission in view of Nagashima et al. and Kaneda further disclose the claimed invention but are silent to the linear drives being arranged in the stereomicroscope housing and between the lens pairs. Official Notice is taken that having linear drives being arranged in a device housing is well known in the art. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the linear drives of Admission in view of Nagashima et al. and Kaneda be arranged in the stereomicroscope housing in order to protect against foreign particles, etc. which would interfere with the operation of the motors. Further, it would have been obvious to one having ordinary skill in the art at the time the invention was made to rearrange the driving motors of Admission in view of Nagashima et al. and Kaneda to be between the lens pairs, since it has been held that a mere rearrangement of an element without modification of the operation of the device involves only routine skill in the art. One would have been motivated to rearrange the driving motors to be between the lens pairs again for the purpose of making the overall device more compact. *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950). It is noted as directed by the MPEP 2144.03 that if the applicant does not seasonably traverse the well-known statement during examination, then the object of the

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well-known statement is taken to be admitted prior art. *In re Chevenard*, 139 F.2d 71, 60 USPQ 239 (CCPA 1943). As such, the above official notice statement of the examiner is now held to be admitted prior art.

Regarding claim 21, Admission further discloses two lens members (L1 and L2) that comprise at least one moving lens system (fig. 1). Admission discloses the claimed invention except for the two lens members being controlled independently from one another and driven separately. Nagashima teaches a zoom system wherein two lens members (2 and 3) are being controlled independently from one another and driven separately (through 9 and 10). It would have been obvious to one having ordinary skill in the art at the time the invention was made to make each of the lens members of Admission be controlled and driven separately, as suggested by Nagashima to provide further flexibility and improved accuracy (Nagashima, column 1, lines 40-44)

Regarding claims 25-26, 28 and 30, Admission in view of Nagashima et al. and Kaneda as applied to claim 13 above, disclose the claimed invention except for the control unit operable to perform an initialization of the first and second direct driving motors to find a predetermined position upon power-up or to find a zero point for the two motors. Kaneda further disclose in column 12, lines 22-31 where a control unit (410) operable to perform an initialization of direct driving motors (145 and 162) to find a predetermined position upon power-up (datum reset position, column 12, lines 30-31) which is a zero point for the two motors (in so far as the pulse counting begins at zero). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the control unit of Admission in view of Nagashima et al.

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and Kaneda perform an initialization to be able to more accurately measure zooming distances and lens positions.

5. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Admission in view of Nagashima et al. and Kaneda as applied to claim 13 above, and further in view of Pensel et al, US 5,867,308.

Admission in view of Nagashima et al. and Kaneda as applied to claim 13 above disclose the claimed invention except for a linear magnification that is adjusted is determined and displayed during the controlling of the zoom system. Pensel et al. teach a linear magnification that is adjusted is determined and displayed during the controlling of the zoom system (12, fig. 1). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the linear magnification of Admission in view of Nagashima et al. and Kaneda that is adjusted be determined and displayed as Pensel et al. suggests in order to arrive at a desired magnification with ease.

6. Claims 27 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Admission in view of Nagashima et al. and Kaneda as applied to claims 26 and 30 above, and further in view of Hirasawa, US 5,570,236.

Admission in view of Nagashima et al. and Kaneda as applied to claims 26 and 30 above disclose the claimed invention except for wherein the initialization includes directing the two motors to move the first and second moving lenses to their lowest magnification. Hirasawa teaches in fig. 8(a), step S16 and column 7, lines 59-60, that the initialization can include

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directing the motors to move the zooming lenses to their lowest magnification. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the initialization include moving the motors to their lowest magnification as suggested by Hirasawa to provide a more consistent initialization/starting point for faster control calculations.

### *Response to Arguments*

7. Applicant's arguments filed 30 October 2005 have been fully considered but they are not persuasive.

Applicant argues that the prior art, specifically Nagashima et al. and Kaneda, do not meet the newly added claim limitation of the control unit controlling the motors according to the mathematical controlling curve “without regard to the position of a specimen to be observed” (see remarks, page 7, paragraph 4). The examiner respectfully disagrees and would like to point out that the admitted prior art, Admission, does meet the limitation (see fig. 1) in that only the mechanical curve is followed.

8. It is noted by the Examiner that the claim objections made in the previous Office Action have been withdrawn due to amendment by the Applicant.

### *Conclusion*

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lee Fineman whose telephone number is (571) 272-2313. The examiner can normally be reached on Monday - Friday 7:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



LAF

January 5, 2006



MARK A. ROBINSON  
PRIMARY EXAMINER